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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,212	10/30/2003	David R. Hennings	NSL-501	2780
34313 7590 09/26/2008 ORRICK, HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558				
EXAMINER SHAY, DAVID M				
ART UNIT 3735		PAPER NUMBER		
MAIL DATE 09/26/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: DAVID R. HENNINGS, MITCHELL P. GOLDMAN, ROBERT
A. WEISS, ERIC B. TAYLOR, and DON JOHNSON

Application No. 10/699,212
Technology Center 1600

Mailed: September 26, 2008

Before KRISTA ZELE *Deputy Chief Appeals Administrator*
ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on June 30, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S ANSWER,
INCONSISTENCIES WITH THE BRIEF AND/OR
LAST REJECTION OF RECORD

A review of the file finds inconsistencies between the last rejection of record, and corresponding GROUNDS OF REJECTION sections in the Appeal Brief and the examiner's answer as set forth below.

Final Rejection

A review of the Final Rejection mailed on February 12, 2007, finds the following status of the claims: claims cancelled: NONE, claims allowed: NONE, claims rejected: 1-17, 19-23, 25-46, claims withdrawn: NONE.

A further review of the file finds that no amendment after final was filed.

Appeal Brief

A review of the Appeal Brief filed on October 29, 2007, finds that the status of claims is different or unclear as compared to the last rejection of record, including any entered after final amendments. The STATUS OF CLAIMS states that "claims 1-17 and 19-23 and 25-46 are pending in this application, and lists claims 18 and 24 as cancelled" however in the GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL claims 26-34 is excluded as being rejected under 35 U.S.C § 103(a) which conflicts with the last office action.

Examiner's Answer

A review of the Examiner's Answer mailed on March 17, 2008, finds that the status of claims is different or unclear as compared to the last rejection of record and/or as compared to the Brief.

Specifically, the GROUNDS OF REJECTION SECTION excludes claims 26-34 as rejected as compared to the same claims being rejected in the Office Action Summary page of the last office action.

INFORMATION DISCLOSURE STATEMENT

Appellants filed an Information Disclosure Statement (IDS) dated June 21, 2004. There is no indication on the record that the Examiner has considered the above Information Disclosure Statement. MPEP § 609 requires the Examiner to consider any Information Disclosure Statement filed by Applicant if timely submitted. **A written communication notifying Appellants of the Examiner's consideration of the above Information Disclosure Statement is required.**

EXAMINER'S ANSWER

A review of the file finds that the status of the claims as provided in the response to arguments section of the Examiner's Answer mailed March 17, 2008 (page 11) is not consistent with the status of claims of record in accordance with 37 CFR 41.37(c)(1)(iii). The status of the claims as provided in both the Examiner's Answer and the Appeal Brief must be

consistent with the last **entered** amendment. Each claim on appeal must be identified. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

A review of the last entered amendment finds that claim(s) 18 is CANCELLED; whereas the examiner on page 11 of the Answer has improperly listed this claim as REJECTED. Correction is required.

TIMELINESS/ FEES

The review of the file reveals that the REQUEST FOR ORAL HEARING filed October 29, 2007 in the APPEAL BRIEF is missing the applicable filing fee(s) and was not filed as a separate paper in accordance with 37 CFR 41.47(d).

CONCLUSION

Accordingly, it is
ORDERED that the application is returned to the Examiner to:

- (1) review the above inconsistencies to determine how to clarify the record;
- (2) vacate the Examiner's Answer mailed on March 17, 2008, and
- (3) issue a corrected Examiner's Answer to correct the GROUNDS OF REJECTION SECTION and to correct other sections of the Answer as may be required;

(4) to include the necessary approval from the TC Director or designee in accordance with MPEP 1207.05, part (B) as may be required for any new grounds of rejection;

(5) consider the Information Disclosure Statement filed June 21, 2004;

(6) to generate a new Examiner's Answer setting forth the correct status of claims and to correct other sections of the Answer as may be required; and

(7) to notify appellant that the REQUEST FOR ORAL HEARING filed on October 29, 2007 is missing the necessary filing fee and was not properly filed as a separate paper in accordance with 37 CFR 41.47(d); and

(8) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/Ssc:

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